

REMARKS/ARGUMENTS

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

Claims 1-31 are presently active in this case. No amendments are made herein and no change in scope of the claims is contemplated by this response.

In the outstanding Official Action, Claims 1, 3-6, 10, 12, 17, 19, 23, 25, 27, 28 and 30 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-21 of copending application serial no. 10/159,953; and Claims 2, 7-9, 11, 13-16, 18, 20-22, 24, 26, 29 and 31 were objected to as being depending upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

First, Applicants wish to thank Examiner Kiliman for the February 11, 2004 personal interview, at which time the outstanding issues in this case were discussed. During the discussion, Applicants presented arguments as to why the claims of the present application patentably define over the '953 claims. Examiner Kiliman indicated that the composition magnetic material Claims 19-21 of the '953 application were canceled, leaving only method claims pending in that application. Examiner Kiliman explained that, as the claims of the present application are composition and device claims, the method claims of the '953 application cannot properly serve as the basis for double patenting rejection. However, Applicants believe that Claims 19-21 have not been canceled in the '953 application. Therefore, Applicants again take the position that the present claims patentably define over the '953 Application.

Specifically, Applicants' invention is directed to a composite magnetic material, a composite dielectric material, and an electronic part using a composite material. As

described in detail in the background section of Applicants' specification, Applicants discovered several problems associated with prior art composite magnetic and composite dielectric materials.¹ In general, the background section of Applicants' specification explains that prior art composite magnetic materials are not highly electrically insulating, easy to work in preparing a molding material having a high saturated magnetic flux density, free of a corrosion problem and having improved high-frequency characteristics and withstanding voltage.² Also generally explained is that prior art composite dielectric material could not exhibit a higher dielectric constant even at low content of dielectric at low material cost.³ Applicants' invention is directed to overcoming these problems.

Specifically, Applicants' Claims 1, 12, 25, 27 and 28 recite composite material including generally spherical particles having a mean particle size of .1 to 10 μm and coated over at least a part of their surface, the coated particles being dispersed in a resin. In contrast, Claims 19-21 of the '953 application recite only a magnetic metal powder having Fe particles with a mean particle size of .1-20 μm coated with the coating layer. Thus, the claims of the '957 application do not recite that the particles are generally spherical in shape, have a mean particle size of .1 to 10 μm , or that the particles are dispersed in a resin.

While the Official Action takes the position that the metal particles of the '953 claims are spherical in shape, this limitation is not recited in the '953 claims. In this regard, Applicants note that it is the claims of the '953 application (specifically, Claims 19-21) that serve as the basis for the double patenting rejection, and the disclosure of the '953 application generally cannot serve as the basis for the double patenting rejection. Moreover, the Official Action fails to recognize the narrower particle size range of the present claims, and merely

¹ See Applicants' specification at page 3, line 25 – page 12, line 8.

² See Applicants' specification at page 11, lines 12-17.

³ See Applicants' specification at page 11, lines 29-35.

concludes that the dispersing in a resin is obvious. Applicants respectfully submit that these claim differences of the present application over the '953 claims are not obvious.

First, Applicants note that the problems discussed in the background section of Applicants' specification were recognized by Applicants for the first time. It is settled law that "a patentable invention may lie in the discovery of the source of the problem even though the remedy may be obvious once the source of the problem is identified."⁴ While the disclosure of the '957 application generally cannot serve as a basis for a double patenting rejection, it is noted that the '957 disclosure does not discuss the problems discussed in the background section of the present application and therefore the '957 claims cannot be directed to solving the problems discovered by Applicants in this case.

Moreover, Applicants submit that the combination of the particles being generally spherical in shape, having a mean size of .1 to 10 μm and being dispersed in a resin provides unexpected results over the invention claims in the '953 application. For example, as described in Applicants' specification, since the invention provides generally spherical metal particles of a small size coated with an insulating layer and having a good dispersibility dispersed in a resin, the resulting composite magnetic material is highly electrically insulating due to particle surface coating, easy to work in its preparation, free of corrosion problems, and has improved high frequency characteristics and withstands voltage.⁵ Still further, since the invention provides a powder of metal particles coated with a dielectric layer mixed and dispersed in a resin, the resulting composite dielectric material has a high dielectric constant even at a reduced content of dielectric and hence, a reduced material cost.⁶ Thus, independent Claims 1, 12, 25, 27 and 28 patentably define over the claims of the '957 application. Moreover, as the remaining pending claims in this case depend from

⁴ In re Sponoble 160 USPQ 237, 243 (CCPA 1968).

⁵ See Applicant's specification at page 77, lines 44-20.

⁶ See Applicants' specification at page 77, lines 4-20.

independent Claims 1, 12, 25, 27 or 28, these remaining pending claims also patentably define over the cited references.

Consequently, in view of the present amendment, no further issues are believed to be outstanding in the present application and the present application is believed to be in condition for formal allowance. An early and favorable action is therefore respectfully requested.

Respectfully submitted,

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